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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,226	12/20/2006	David Knaack	C00000002.02	5785
11556 7590 07/19/2011 Medtronic Inc. (Spinal/Osteotech) 710 Medtronic Parkway Attn: Legal Patents MS: LC340 Minneapolis, MN 55432-5604				
EXAMINER				
AZPURU, CARLOS A				
ART UNIT		PAPER NUMBER		
1617				
NOTIFICATION DATE		DELIVERY MODE		
07/19/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Medtronic_spinal_docketing@cardinal-ip.com

Office Action Summary

Application No.

10/589,226

Applicant(s)

KNAACK ET AL.

Examiner

CARLOS AZPURU

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 16-21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 9-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ ~~Copies of the certified copies of the priority documents have been received in this National Stage~~ application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 12062006, 11252008, 03192009 and 11112010

- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the information disclosure statement filed 08/11/2006.

Information Disclosure Statement

Receipt is acknowledged of the information disclosure statements filed 12/06/2006, 11/25/2008, 03/19./2009, and 11/11/2010.

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-21 and 23-25. in the reply filed on 05/02/2011 is acknowledged.

Claims 26, 30-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05/02/2011.

Specification

The abstract of the disclosure is objected to because it is the Abstract of the PCT application. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 16-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03030956 (Osteotech, Inc.).

Osteotech, Inc claims a an implantable bone growth implant comprising a matrix, a growth factor and a stabilizing agent (claim 1). The matrix can be demineralized bone (DMB)(claim 9).Agents used to protect the matrix are listed at [07], and include enzyme inhibitors generally, and protease inhibitors in specific. The composition may contain stabilizing agents at [39]. The particles or fibers of the DMB are disclosed at [22]. Water and hyaluronic acid may be added as disclosed at [47]. Specific protease inhibitors are found at [24]. Osteoinductive agents are listed at [52]. Polysaccharides are listed as possible carriers at [42]. Those of ordinary skill would have found it well within their skill to claim the instant composition with a reasonable expectation of similar osteoinductivity at one year given that the same composition is disclosed by Osteotech, Inc. As such, the instant composition would have been obvious to one of ordinary skill in the art at the time of invention given the disclosure of Osteotech, Inc.

Claims 9-15 are objected to as dependent upon a rejected base claim.

Conclusion

No claims are allowed.

US Patent No, 6,468,543 is cited as patent of interest in its disclosure of a
dimineralized bone matrix composition with a stabilizing agent, and non-polyol carriers.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to CARLOS AZPURU whose telephone number is
(571)272-0588. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fereydoun G. Sajjadi can be reached on (571) 272-3311. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos A. Azpuru/
Primary Examiner, Art Unit 1617

Carlos A. Azpuru
Primary Examiner
Art Unit 1617

caz